

REMARKS

Summary of the Office Action

Claim 1 is objected to for having two (2) periods, at lines 6 and 8.

Claim 12 is objected to for missing a period.

Claims 1-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-3, 5-11, 14-16, 18, and 20-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Cardwell et al.* (U.S. Pat. No. 6,895,403).

Claims 4, 13, 17, and 24-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cardwell et al.* (U.S. Pat. No. 6,895,403), in view of *Selling by Objective* (SBO), May 1984.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cardwell et al.* (U.S. Pat. No. 6,895,403) in view of *Jannette et al.* (U.S. Pat. No. 6,036,345).

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Cardwell et al.* (U.S. Pat. No. 6,895,403).

Summary of the Response to the Office Action

Applicants amend independent claims 1, 9, 15, 24, and 30 and amend dependent claims 25-29 and 31-35 to improve their form. Accordingly, claims 1-35 are presently pending.

Claim Objections

Claim 1 is objected to for having two (2) periods, at lines 6 and 8. Claim 12 is objected to for missing a period. Applicants have amended claims 1 and 12 to correct the claim objections.

The Rejection under 35 U.S.C. § 101

Claims 1-14 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Office Action bases this rejection on a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

The Office Action asserts that the claimed invention satisfies prong 1 of this test, in that it “[produces] a useful, concrete, and tangible result”, but fails prong 2 for not being “within the technological arts.” Applicants respectfully traverse these rejections for at least the following reasons.

All Subject Matter Complies with 35 U.S.C. § 101

The September 23, 2005 Office Action rejects the present invention for failing prong 1 of the 35 U.S.C. § 101 two-prong test above. The Office Action admits the present invention satisfies prong 2 in that it “[produces] a useful, concrete, and tangible result”, but fails prong 1 for not being “within the technological arts.”

Subsequent to September 23, 2005, the Board of Patent Appeals and Interferences decided *Ex parte Lundgren*, 76 U.S.P.Q.2d 1385 (2005). Pursuant to the Board’s Standard Operating Procedure 2, the Board designated *Lundgren* a precedential opinion. The *Lundgren*

invention, like the present invention, disclosed an invention the Office found to produce a “useful, concrete, and tangible result”, but the Office rejected the claims for not being “within the technological arts.” The Board overruled the *Lundgren* Office Action, stating it was the Board’s determination that “there is no judicially recognized separate ‘technological arts’ test to determine patent eligible subject matter under [35 U.S.C.] § 101.” *Ex parte Lundgren*, 76 U.S.P.Q.2d 1385 (2005). Accordingly, Applicants respectfully assert that claims 1-14 are allowable under 35 U.S.C. § 101 for the reasons set forth above. As a result, Applicants respectfully assert that the rejection under 35 U.S.C. § 101 should be withdrawn.

The Rejections under 35 U.S.C. § 102(e)

Claims 1-3, 5-11, 14-16, and 20-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *Cardwell et al.* (U.S. Pat. No. 6,895,403). Applicants respectfully traverse these rejections for at least the following reasons.

All Subject Matter Complies with 35 U.S.C. § 102(e)

The present invention as recited in independent claim 1, as amended, includes a “multi-dimensional matrix” method for managing an objectives-based business plan defining major and minor objectives according to one or more parameters “on four axes simultaneously.” Applicants respectfully assert that at least these features are neither taught nor suggested by *Cardwell et al.*

In contrast to the present invention, *Cardwell et al.* disclose a hierarchical management method for managing an objectives-based business plan that looks at various parameters individually. The hierarchical management method disclosed teaches away from the multi-

dimensional matrix method of the present invention because *Cardwell et al.* divide a system into “as many pieces as necessary,” or “start as one piece and have divergent pieces from there.” Col. 5, lines 44-47. *Cardwell et al.* disclose evaluating parameters in isolation, not on four axes simultaneously, as disclosed in amended claim 1 of the present invention. Instead, “upper management” determines the future of the organization, col. 5, lines 19-21, evaluating parameters in isolation.

Accordingly, Applicants respectfully assert that independent claim 1, as amended, is allowable over *Cardwell et al.* Moreover, Applicants respectfully submit that dependent claims 2-3 and 5-8 are allowable at least because of their respective dependencies from independent claim 1, and the reasons set forth above.

The present invention as recited in claim 9, as amended, includes a “multi-dimensional matrix” method for managing an objectives-based business plan defining major and minor objectives “according to one or more parameters on four axes simultaneously.” Management performance is measured by how management achieves major objectives on all four axes, and team performance is measured by how teams achieve related minor objectives on all four axes.

In contrast to the present invention, *Cardwell et al.* disclose a system where management sets the scope, authority, and limits for each priority individually. Col 6, lines 57-61. *Cardwell et al.* evaluate manager and team member performance based on single-variable criteria, in contrast to the multi-dimensional matrix evaluation of manager and team performance on four axes of the present invention. Performance in *Cardwell* is evaluated on accomplishment of “chronological listing[s]” of “specific outcomes,” of a single portion of the project. Col. 7 lines

49-51. Further, priorities are “broken up” into multiple pieces, col. 5, lines 58-59, with no evaluation of how performance in one area affects performance in other project areas. Col 5, lines 57-58.

Accordingly, Applicants respectfully assert that independent claim 9, as amended, is allowable over *Cardwell et al.* Moreover, Applicants respectfully submit that dependent claims 10, 11, and 14 are allowable at least because of their respective dependencies from independent claim 9, and the reasons set forth above.

The Office Action also rejects independent claim 15 as the system claim corresponding to the method of independent claim 1 and dependent claim 3, rejected above. Applicants respectfully assert that independent claim 15 is allowable over *Cardwell et al.* for the reasons set forth above. Moreover, Applicants respectfully submit that dependent claims 16, 18, and 20-23 are allowable at least because of their respective dependencies from independent claim 15, and the reasons set above. As a result, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn.

The Rejections under 35 U.S.C. § 103(a)

Claims 4, 13, 17, and 24-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Cardwell et al.* (U.S. Pat. No. 6,895,403) in view of *Selling By Objective* (SBO), May 1984. Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Cardwell et al.* in view of *Jannette et al.* (U.S. Pat. No. 6,036,345). Claim 19 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Cardwell et al.*

The Office Action asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a product, territory, an application, and an account as an effective step in determining objectives, as taught by *Cardwell et al.* in view of SBO. The Office Action further asserts that it would have been obvious to include expressing progress status codes as an effective means of determining performance status. The Office Action further asserts that it would have been obvious as taught by *Cardwell et al.* in view of *Jannette et al.* to include a team manager and members determining their own objectives as an effective means of empowering individual team and team members. Finally, the Office Action asserts that it would have been obvious in view of *Cardwell et al.* to include e-mail as an effective means of communication.

All Subject Matter Complies with 35 U.S.C. § 103(a)

The present invention as recited in amended independent claims 1, 9, 15, 24, and 30 includes a “multi-dimensional matrix” method for defining and managing major and minor objectives “on four axes simultaneously.” Applicants respectfully submit that at least these features are neither taught nor suggested by *Cardwell et al.* and Selling by Objective, May 1984 (SBO), whether taken singly or combined.

In contrast to the present invention, *Cardwell et al.* teaches a hierarchical process, beginning at the organizational level, and working down to the individual level. Col. 4, lines 36-42. Individual teams are assigned to a “particular” business priority. Each step is done sequentially, and the scope of the project is not discussed at the next level until it has “trickled down” from the level above. Col. 6, lines 30-31. This teaches away from the multi-dimensional

matrix management method of the present invention, and as the Office Action admits, *Cardwell et al.* do not specifically disclose a multi-dimensional matrix.

Moreover, in contrast to the present invention, *Cardwell et al.* look at individual priorities. Col. 8, line 59. As shown in example A, columns 4-5, *Cardwell et al.* list priorities in a single column. Each priority is evaluated independently of the others, using fixed subcategories specific to the particular criterion. Col. 6, lines 46-48.

In contrast to the present invention, SBO teaches a method of setting priorities (objectives), evaluating them on a periodic basis, and measuring their achievement independently. SBO, paragraph 5. Each objective is evaluated independently of other priorities. The parameters used to measure each objective in SBO are merely subobjectives of an isolated objective. SBO paragraph 10. This teaches away from defining and managing objectives on four axes simultaneously, as claimed in the present invention. Accordingly, Applicants respectfully assert that amended independent claims 1, 9, 15, 24, and 30 are allowable over *Cardwell et al.* and SBO, whether taken singly or combined. Moreover, Applicants respectfully assert that dependent claims 4, 13, 17, 19, 25-29, and 31-35 also are allowable at least because of their respective dependencies from independent claims 1, 9, 15, 24, and 30, and the reasons set forth above.

The Office Action further rejects claim 12 as being unpatentable over *Cardwell et al.* in view of *Jannette et al.* (U.S. Pat. No. 6,036,345). *Jannette et al.* disclose a management system for engineering project planning and design. Summary of the Invention, col. 2, line 37.

In contrast to the present invention, *Jannette et al.* teach the a hierarchical management method, with a single team responsible for the entire project. Col. 4, lines 59-60. This teaches away from a “multi-dimensional matrix” management approach. *Cardwell et al.* fail to overcome the deficiencies of *Jannette et al.* for the reasons given above. Accordingly, Applicants respectfully assert that claim 12 is allowable over *Jannette* and *Cardwell*, whether taken singly or combined.

The Office bears the initial burden of establishing a *prima facie* case of obviousness. MPEP § 2142. If the Office fails to set forth a *prima facie* case of obviousness, Applicants are under “no obligation to submit evidence of nonobviousness.” *Id.* In other words, if the Office fails to meet the initial burden of establishing a *prima facie* case of obviousness as to a given claim, that claim is not obvious even absent any evidence of nonobviousness by the Applicants.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

The Office Action has not established a *prima facie* case of obviousness at least because neither *Cardwell et al.*, SBO, nor *Jannette et al.*, whether alone or in combination, teach or suggest all the recited features of amended independent claims 1, 9, 15, 24, and 30. Namely, neither *Cardwell et al.*, SBO, nor *Jannette et al.* teach or suggest a “multi-dimensional matrix”

method for defining and managing major and minor objectives “on four axes simultaneously” as recited in amended independent claims 1, 9, 15, 24, and 30.

As pointed out in MPEP § 2143.03, “[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because neither *Cardwell et al.* and SBO nor *Cardwell et al.* and *Jannette et al.* teach or suggest each and every feature of amended independent claims 1, 9, 15, 24, and 30, or dependent claims 4, 12, 13, 17, 19, 25-29, and 31-35.

Applicants respectfully submit that dependent claims 4, 12, 13, 17, 19, 25-29, and 31-35 are allowable insofar as they recite the patentable combinations of features recited in amended independent claims 1, 9, 15, 24, and 30, as well as reciting additional features that further distinguish over the applied prior art. Claims 1, 9, 15, 24, and 30 are amended to define differently the invention. Applicants respectfully submit that claims 1, 9, 15, 24, and 30 as amended are patentable over the art of record. As a result, Applicants respectfully assert that the rejection under 35 U.S.C. § 103(a) should be withdrawn.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding

after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted

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